

U.S. Patent Application No. 09/694,593
Attorney's Docket No. 99-317 CIP

REMARKS

This amendment is responsive to the Office Action¹ dated September 27, 2004. Claims 1-37 were presented for examination. All claims were rejected. No claims are canceled or added. Thus, claims 1-37 remain pending. Claims 1, 14, 21, 22, 29, 36 and 37 are independent claims and all have been amended. No new matter is added. Support for these amendments is found in the application as filed, for example, in Fig. 7, blocks 710, 715 and 720. Also, the specification has been amended to correct for minor typographical and clerical errors; no new matter is added.

In the Office Action, the Examiner applies three references against Applicant's claims, namely: Mattaway et al., U.S. Patent Number 6,275,490 (hereinafter "Mattaway"); Wiener et al., U.S. Patent Number 6,324,264 (hereinafter "Wiener"); and Mueller et al., U.S. Patent Number 6,052,411 (hereinafter "Mueller").

Claims 1-3, 5-6, 8, 13-14, 16, 21-24, 28-29, 31, 36 and 37 are rejected under 35 U.S.C. § 102(e) as being anticipated by Mattaway.

Claims 4, 11, 19, 25-26 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mattaway in view of Wiener.

Claims 7, 9-10, 15, 17-18, 30, 32-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mattaway and further in view of Mueller.

¹ The Office Action may contain a number of statements characterizing the cited references and/or the claims which Applicant may not expressly identify herein. Regardless of whether or not any of those statements is identified herein, Applicant does not automatically subscribe to, or acquiesce in, any of those statements.

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Claims 12, 20, 27 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mattaway in view of Wiener and further in view of Mueller.

Applicant respectfully traverses all of these rejections for the following reasons:

35 U.S.C. § 102(e) Rejection:

Claims 1-3, 5-6, 8, 13-14, 16, 21-24, 28-29, 31, 36 and 37 are rejected under 35 U.S.C. § 102(e) as being anticipated by Mattaway. Consider amended independent claim 1, for example, which recites a combination of features:

“A method of making a telephone call using an electronic document stored in a computer, comprising: retrieving the electronic document, the electronic document including data representing at least one telephone number; selecting a first telephone number from the electronic document to obtain a selected telephone number; signaling, from the computer via a packet-switched network coupled to a first line, a telecommunication system to connect a call between a first telephone associated with the first telephone number and a second telephone associated with a calling party telephone number in response to the selection of the first telephone number, the calling party telephone number being stored in the computer, the call being connected via the first line; and subsequent to attempting the call, using the stored calling party telephone number to connect all calls from the calling party to any telephone number including the selected telephone number.”

In the Office Action, page 5, paragraph 17, the Examiner states “Mattaway does not expressly disclose receiving, prior to signaling, the calling party telephone number; and storing the calling party telephone number.” Since claim 1 recites language which indicates at least that the calling party number is stored in the computer, Mattaway does not disclose or suggest all claim elements of claim 1. Referring to MPEP § 2131, “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051 1053 (Fed. Cir. 1987).” Accordingly, since at least certain claim elements in

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amended claim 1 are not found in Mattaway, the rejection of claim 1 under 35 U.S.C. § 102(e) should be withdrawn and the claim allowed. Likewise, amended independent claims 14, 21, 22, 29, 36 and 37 contain limitations that are identical or similar to this limitation presently being discussed in regard to claim 1. Accordingly the 35 U.S.C. § 102(e) rejection of these claims should also be withdrawn and the claims allowed.

Each of dependent claims 2-3, 5-6, 8, 13, 16, 23-24, 28 and 31 depends directly or indirectly from one of independent claims 1, 14, 22 and 29. Therefore, the 35 U.S.C. § 102(e) rejection of these claims should also be withdrawn and the claims allowed, at least for reasons based on their direct or indirect dependencies from these independent claims.

35 U.S.C. § 103(a) Rejection:

Claims 4, 11, 19, 25-26 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mattaway in view of Wiener. Claims 7, 9-10, 15, 17-18, 30, and 32-33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mattaway and further in view of Mueller. And, claims 12, 20, 27 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Mattaway in view of Wiener and further in view of Mueller.

In parent application U.S. Serial No. 09/620,484, filed July 20, 2000, the Examiner therein being the same Examiner as in the instant application, an advisory action was issued in which the Examiner urges Applicant to amend the claims in the parent application to further distinguish them over the same cited prior art (i.e., Mattaway and Wiener). Furthermore, the Examiner, in that advisory action, suggested a limitation specifying that the calling party telephone number is stored in the memory of the computer only once where the stored calling

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party telephone number is used each time a call it attempted. Applicant, in the parent application, followed the suggestion made by the Examiner in the parent application, and amended those claims accordingly. Applicant agrees with the Examiner that Mattaway or Wiener taken alone or in any reasonable combination does not disclose or suggest subject matter of Applicant's amended claims in the parent application.

Applicant is being guided by that same suggestion in the instant application in view of the commonality of at least some of the claimed subject matter, and the commonality of at least some of the cited references (Mattaway and Wiener). Mueller is also cited in this instant continuation-in-part application, but not in the parent application. Mueller has been reviewed, and it is clear that Mueller also does not disclose or suggest at least the limitation of subsequent to attempting the call, using the stored calling party telephone number to connect all calls from the calling party to any telephone number including the selected telephone number as substantially recited in each of the independent claims herein. Therefore, applicant respectfully submits that Mueller, taken alone, or in combination with the other references also does not disclose or suggest the subject matter of Applicant's amended claims.

Accordingly, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections of claims 4, 11, 19, 25-26 and 34 as being un-patentable over Mattaway in view of Wiener, claims 7, 9-10, 15, 17-18, 30, and 32-33 as being un-patentable over Mattaway in view of Mueller, and claims 12, 20, 27 and 35 as being unpatentable over Mattaway in view of Wiener and further in view of Mueller should all be withdrawn and the claims allowed.

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The language of the instant amendment is directed to operation of Applicant's claimed subject matter wherein: after the calling party telephone number is stored, the stored number is used in any future calls from that calling party. This is shown in Fig. 7 and is what the Examiner suggested in the parent application. Applicant is adopting this language suggestion into this instant application solely for purposes of substantially advancing the prosecution of this instant application.

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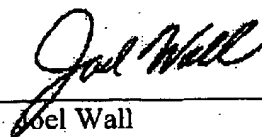
CONCLUSION

In view of the foregoing amendments and remarks, all pending claims are urged to be allowable over the cited references. Applicant respectfully requests the Examiner's reconsideration of this application, and the timely allowance of the pending claims. If any questions remain, the Examiner is invited to contact the undersigned at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 07-2347 and please credit any excess fees to such deposit account.

Respectfully submitted,

By: _____



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